

STATUS OF THE CLAIM

The status of the claims in this application is:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION: Claims
originally filed in this application are:
Claims 1 - 11.

B. STATUS OF ALL THE CLAIMS.

1. Claims canceled: Claims 1 and 3 - 11.
2. Claims withdrawn from consideration but not
canceled: None.
3. Claim pending: Claim 2.
4. Claims allowed: None.
5. Claim rejected: Claim 2.
6. Allowable Claims: None.

STATUS OF AMENDMENTS

A first Office Action was issued October 19, 2001, which objected to the drawings and to Claim 1 for informalities. Claims 1 - 11 were rejected "under 35 U.S.C. 112, as being indefinite". In addition Claims 1 - 4, 8 - 11 were rejected "under 35 U.S.C. 103(a) as being unpatentable over Hanrath 940873, Fisher 5746001, Beeber 2994958 and Exhibit 1 by Lufkin . . ." Claim 5 was rejected "under 35 U.S.C. 103(a) as being unpatentable over Hanrath, Fisher, Beeber and Lufkin as

applied to claims 1-4, 8-11 above, and further in view of JP 405005601 . . .” Lastly, Claims 6 and 7 were rejected “under 35 U.S.C. 103(a) as being unpatentable over Hanrath, Fisher, Beeber and Lufkin as applied to claims 1-4, 8-11 above, and further in view of Ward 202610.”

Applicant filed an amendment January 17, 2002, in which the Examiner’s attention was drawn to references in the drawings. Claims 1 and 2, the only independent claims, were amended. Arguments were made in support of an allowance.

A first Final Office Action was forwarded 5/9/2002 in which rejections based on 35 U.S.C. 112 were dropped. Claim 1 was objected to. Claims 1 - 11 were rejected as being unpatentable over the prior art identical with that cited and applied in the first office action.

A proposed amendment after final rejection was mailed July 9, 2002, canceling all claims but Claim 2.

In an advisory Office Action dated August 1, 2002, note was taken that the proposed amendment was not entered since it raised new issues.

A Request for Continued Examination was mailed August 8, 2002, in which it was requested that the Amendment mailed July 9, 2002 be entered.

On September 25, 2002, a non-final Office Action was issued in which the previously un-entered amendment was entered and

Claim 2, the only remaining claim was rejected "under 35 U.S.C. 103(a) as being unpatentable over Wall (U.S. 5230158) in view of Troyer et al. (U.S. 4149320) . . ."

An Amendment was mailed December 26, 2002, in which Claim 2 was amended and arguments were presented in support of an allowance.

Thereafter, on March 26, 2003, a final Office Action issued rejecting Claim 2 "under 35 U.S.C. 112 as being indefinite" and as being unpatentable "under U.S.C. 103(a) as being unpatentable over Marshall (U.S. RE 37212E) in view of Jones, Jr. (U.S. 5335421) [hereinafter Jones] and the Prior Art as stated in Fig. 1 by Sarasin (U.S. 4970797) [hereinafter Prior Art].

In response to the final Office Action, a proposed amendment was submitted May 29, 2003.

An Advisory Action dated July 21, 2003 advised that the proposed amendment would not be entered since it allegedly raised new matter.

A Notice of Appeal with a 3-month extension of time was mailed September 16, 2003.

SUMMARY OF THE INVENTION

The invention is a tape measure system 10. The system comprises a tape 14 of a disposable material with limited extensibility. The tape has a short leading edge 16 and a parallel short trailing edge 18 and long parallel side

edges 20, 22 between the leading and trailing edges. The side edges include a first side edge 20 and a second side edge 22 with a central extent there between 30. The tape has a front face 24 and a rear face 26.

Indicia is formed on the front face and consists of continuing first indicia lines 32 equally spaced at a first distance along the entire central extent of the tape. The indicia also consists of continuing repeating second indicia lines 38 along the first side edge laterally spaced from the first indicia lines with the second indicia lines being equally spaced at a second distance different from the first distance. The indicia also consists of continuing repeating third indicia lines 40 along the second side edge laterally spaced from the first indicia lines with the third indicia lines being equally spaced at a third distance different from the first distance and second distance. The first indicia lines and the second indicia lines and the third indicia lines further consist of at least one common indicia line, Figure 5, extending across the entire front face from the first side edge to the second side edge.

ISSUES

Whether the rejection of Claim 2 "under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" is proper.

Whether the rejection of Claim 2 "under 35 U.S.C. 103(a) as being unpatentable over Marshall (U.S. RE 37212E) in view of Jones, Jr. (U.S. 5335421) [hereinafter Jones] and the Prior Art as stated in Fig. 1 by Sarasin (U.S. 4970797) [hereinafter Prior Art]" is proper.

GROUPING OF CLAIMS

Claim 2 is the only remaining claim and may be considered by itself.

ARGUMENT

In the first final rejection, the Examiner rejected Claim 2 because of the use of "consisting of" improperly. It is deemed that as used in this Claim 2, the use of consisting of is not improper since the "continuing first indicia lines" are the only indicia lines along the "entire central extent of the tape" while the "continuing repeating second indicia lines" are the only indicia lines along the "first side edge" and, in addition, the "continuing repeating third indicia lines" are the only indicia "along the second side edge." If, however, the Examiner continues with the rejection on indefiniteness, applicant stands ready to accept an Examiner's amendment changing "consisting of" in these various locations in favor of either ..including.. or ..comprising.. An attempt to correct this indefiniteness was made in response to the second final rejection.

In the second final rejection, the Examiner rejected Claim 2 as being unpatentable over Marshall (U.S. RE 37212E) in view of Jones, Jr. (U.S. 5335421) [hereinafter Jones] and the Prior Art as stated in Fig. 1 by Sarasin (U.S. 4970797) [hereinafter Prior Art]. This rejection is traversed. Claim 2 specifically recites indicia lines along the central extent of the tape with second and third indicia lines adjacent the edges. Specifically recited is the fact that the three types of indicia lines are at different spacings. Such an arrangement is not found anywhere in the prior art. Marshall has second and third edge indicia lines, but they are at a common spacing along their lengths. Further Marshall has no indicia lines in the central extent. The Examiner then turns to Jones for edge indicia lines at different spacings but has no central lines between the edges, let alone central lines at spacings which are different from all of the other spacings.

The Examiner attempts to overcome the deficiency of the prior art by stating that: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the third indicia of the tape disclosed by Marshall with a third indicia, as taught by Jones, so as to have an edge with further different indicia, different fractions of an inch, rather than the other indicia in the tape in order to allow the user to measure different object with the desired accuracy relative to

inch." There is simply no suggestions within Marshall or Jones to modify these references as suggested by the Examiner. The proposed modification by the Examiner would destroy the inventive concept of the references attempted to be combined by the Examiner. Further, even if there were a teaching for the proposed teaching by the Examiner, the resulting structure would still fail to meet the terms of Claim 2 since there would be no "continuing first indicia lines equally spaced at a first distance along the central extent of the tape."

The Examiner then alleges that: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a common indicia line extending through the front face of the indicia as taught by Prior Art to the tape disclosed by Marshall so as to allow the user to tape the measurements in whole numbers and in fractions at the same time and also to see the relationship between the measurements taken in whole and fraction numbers at a short glance." Again, although there is a common line in the "Fig. 1-Prior Art" of the Examiner's attachment 3, such does not meet the terms of applicant's claim wherein the common line extends through and is part of the first indicia lines along the entire central extent as well as the second and third indicia lines at the edges.

Lastly, the Examiner alleges that: "In a broad sense the tape of Marshall's is considered to be 'disposable' since it can

be disposed when it is damaged or worn out." In this regard, there is no teaching or suggestion of anything in the prior art references of a tape measure system fabricated of a "disposable material" as disclosed and claimed. A fair reading of any of the prior art references applied by the Examiner in the final rejection would lead one to the inescapable conclusion that the material of the prior art devices is not intended to be disposable material and, as such, the references do not meet the terms of applicant's invention as claimed.

It would appear that the Examiner has merely gleaned miscellaneous features in the prior art and has attempted to combine them without a teaching for their combination. The only teaching is in applicant's disclosure which, by definition, is not prior art. But even if there were a teaching for the combination, the resulting structure would still fail to anticipate applicant's invention for the reasons set forth herein above.

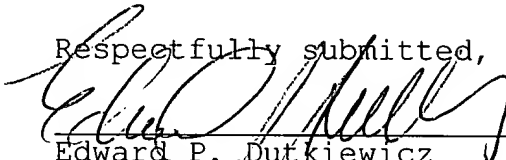
In summary, then, it is urged that applicant's invention is new, not being disclosed in the prior art. Applicant's invention is clearly useful as a significant step forward in the technology and it is urged that applicant's invention is unobvious over the prior art, whether taken alone or in any possible combination. In addition, it is urged that the application is definite in its language.

CONCLUSION

It is requested that the rejections to the claim be withdrawn and the present application be allowed and passed to issue.

Reconsideration, a reversal of the Examiner's position, and a Notice of Allowance are requested.

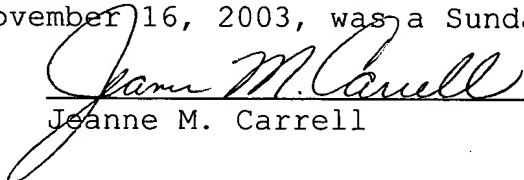
Respectfully submitted,



Edward P. Dutkiewicz
Registration No. 46,676
640 Douglas Avenue
Dunedin, Florida 34698
(727) 734-2855

CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing Appeal Brief and attachments in triplicate is being deposited with the U.S. Postal Service with sufficient First Class postage addressed to: Mail Stop: Appeals, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 17th day of November, 2003. Note is taken that November 16, 2003, was a Sunday.



Jeanne M. Carrell

APPENDIX A

CLEAN VERSION OF CLAIM

What is claimed as being new and desired to be protected by LETTERS PATENT of the United States is as follows:

2. A tape measure system comprising:

a tape of a disposable material with limited extensibility, the tape having a short leading edge and a parallel short trailing edge and having long parallel side edges there between including, a first side edge and a second side edge with a central extent there between, the tape having a front face and a rear face; and

indicia formed on the front face and consisting of continuing first indicia lines equally spaced at a first distance along the entire central extent of the tape, the indicia also consisting of continuing repeating second indicia lines along the first side edge laterally spaced from the first indicia lines with the second indicia lines being equally spaced at a second distance different from the first distance, the indicia also consisting of continuing repeating third indicia lines along the second side edge laterally spaced from the first indicia lines with the third indicia lines being equally spaced at a third distance different from the first distance and second distance, the first indicia lines and the second indicia lines and the third indicia lines further consisting of at least one common

indicia line extending across the entire front face from the first side edge to the second side edge.